

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-83 are presently active in this case. The present amendment amends Claim 71 and adds new Claims 80-83 without introducing new matter. Support for new dependent Claims 80-83 can be found, for example at page 8, paragraphs [0063]-[0064] along with Figs. 1 and 5-6.

The outstanding Office Action objected to an information disclosure statement “because a few of the foreign patents fail to have a English translation.” The Office Action also rejected Claims 1, 13, 17-20, 22, 30, 45, 49-52 and 54 under 35 U.S.C. § 102(b) as anticipated by Zhang et al. (U.S. Patent No. 6,343,717). Claims 4-6 and 36-38 were rejected under 35 U.S.C. § 103(a) as unpatentable over Zhang in view of Lewis (U.S. Patent No. 5,947,986). Claims 7-8, 39 and 40 were rejected under 35 U.S.C. § 103(a) as unpatentable over Zhang in view of Zygmunt (U.S. Patent No 6,488,646). Claims 9-10, 41 and 42 were rejected under 35 U.S.C. § 103(a) as unpatentable over Zhang in view of Barabino et al. (U.S. Patent No. 4,740,194). Claims 11-12, 43 and 44 were rejected under 35 U.S.C. § 103(a) as unpatentable over Zhang in view of Tobin et al. (U.S. Patent No 3,792,699). Claim 31 was rejected under 35 U.S.C. § 103(a) as unpatentable over Barr et al. (U.S. Patent No. 6,812,254). Claims 32-35 were rejected under 35 U.S.C. § 103(a) as unpatentable over Zhang in view of Barr. Claims 71, 74, 76, 78 and 79 were rejected under 35 U.S.C. § 103(a) as unpatentable over Zhang in view of Lewis. Claim 73 was rejected under 35 U.S.C. § 103(a) as unpatentable over Zhang in view of Lewis and further in view of Barr. Claim 75 was rejected under 35 U.S.C. § 103(a) as unpatentable over Zhang in view of Lewis and further in view of Ohsumi (U.S. Patent No. 5,658,981). Claim 77 was rejected under 35 U.S.C. § 103(a) as unpatentable over Zhang in view of Lewis in view of Zygmunt.

Initially, Applicant respectfully requests that each of the references cited in the Information Disclosure Statement (IDS) filed October 1, 2003 be acknowledged as having been considered in the next Office Action. The statement that this IDS failed to comply with the provisions of 37 CFR 1.97 and 1.98 “because a few of the foreign patents fail to have a English translation” is not correct. As explained in MPEP 609.04(a)-III, the requirement for a concise explanation of the relevance for non-English language references can be satisfied by “an English language abstract of the reference” or by the “X”, “Y”, or “A” indication on a search report” citing the reference. The IDS filed October 1, 2003 included either an English abstract and/or the search report citing the reference along with the “X”, “Y”, or “A” indication and a translation for these categories. Thus, the IDS filed October 1, 2003 fully complied with the provisions of 37 CFR 1.97 and 1.98 and acknowledgment of consideration of each reference cited therein is respectfully requested.

In response to the rejections of the claims under 35 U.S.C. § 102(b) and 35 U.S.C. §103(a), Applicant respectfully requests reconsideration of these rejections and traverses the rejections, as discussed next.

Independent Claim 1 recites *inter alia* an evaluation or diagnostic kit comprising ***a plurality of applicators containing different test substances***. Independent Claim 30 recites *inter alia* an evaluation or diagnostic kit comprising ***a plurality of applicators containing test substances with at least one compound at different concentrations***. Independent Claim 71 is amended to specify that the tubes comprise ***different test substances or test substances with at least one compound at different concentrations***. New dependent Claims 80-83 specify these features even more. For example, dependent Claims 80 and 82 recite a first tube containing a first test substance, a second tube containing a second test substance, and a third tube containing a third test substance, “wherein ***said first test substance is different from said second and third test substances, and said second test substance is different from***

said third test substance.” Dependent Claims 81 and 83 recite a first tube containing a first test substance comprising a compound at a first concentration, a second tube containing a second test substance comprising said compound at a second concentration, and a third tube containing a third test substance comprising said compound at a third concentration, *“wherein said first concentration is different from said second and third concentrations, and said second concentration is different from said third concentration.”*

Turning now to the applied prior art, Zhang discloses a pre-filled disposable pipette for pharmaceutical and cosmetic products which has a hollow, round pipette body (40). The body consists of a hollow, rigid bulb section (44) forming a reservoir for storage and dispersion of the liquid pharmaceutical or cosmetic product which is pre-filled within the body. However, and contrary to what is stated in the outstanding Office Action, Zhang fails to disclose a kit comprising a plurality of applicators containing different test substances. Zhang also fails to disclose a kit comprising a plurality of applicators containing test substances with at least one compound at different concentrations.

In fact, the outstanding Office Action acknowledges at page 7 that “Zhang et al. does not disclose a kit comprising at least two test substances with at least one compound at varying concentrations.” This statement is correct as Zhang is silent about any kit that would include a plurality of pipettes with different test substances or test substances having at least one compound at different concentrations.

Therefore, Zhang fails to teach every feature recited in Applicant's claims, so that Applicant respectfully traverses, and requests reconsideration of, the 35 U.S.C. § 102(b) rejections based on the Zhang patent.

The other cited references do not remedy the deficiencies of the Zhang patent. In particular, and contrary to what is suggested in the outstanding Office Action at page 7, Barr does not disclose a kit comprising test substances with substances at varying concentrations.

The Barr patent discloses in the passage cited in the Office Action (col. 3, lines 44-65 and col. 7, line 40 to col. 8, line 38) various possibilities of concentrations or ingredients in one composition but does not disclose or suggest to have at least two substances comprising at least one compound at varying concentrations or to have different test substances in various tubes of a kit, as claimed. There is no disclosure in Barr of at least two different compositions contained in two different tubes included together in a kit.

Further, there is no evidence for a motivation to modify the teachings from the Zhang patent so as to arrive at Applicant's claimed kits. The position that these teachings *could* be modified, or is capable of being modified, to arrive at the claimed kits would be insufficient to establish a *prima facie* case of obviousness.¹

Therefore, the prior art fails to teach or suggest every feature recited in Applicant's claims, so that the pending claims are patentably distinct over the prior art. Accordingly, Applicant respectfully traverses, and requests reconsideration of, the outstanding rejections.²

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-83 is earnestly solicited.

¹ See MPEP 2143.01 stating that the "fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness"; see also same section stating "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so,'" (citation omitted).

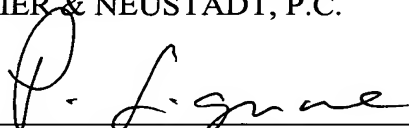
² See MPEP 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

Application No. 10/674,491
Reply to Office Action of September 28, 2006

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Steven P. Weihrouch
Attorney of Record
Registration No. 32,829

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Philippe J.C. Signore, Ph.D.
Registration No. 43,922